



Practitioner's Docket

U 013711-6

PATENT

1746
JPW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Hiroyuki ONISHI, et al

Serial No.: 10/009,884

Group No.: 1746

Filed: November 13, 2001

Examiner: William P. Fletcher III

For: METHOD FOR SURFACE-TREATMENT, SURFACE-TREATED ARTICLE AND
DEVICE FOR SURFACE TREATMENT

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

WARNING: Failure to file a complete response in compliance with § 1.135(c) leads to a reduction in patent term adjustment - See § 1.704(c)(7).

1. Transmitted herewith is an amendment for this application.

STATUS

2. The application is qualified as
☐ a small entity.
☒ other than a small entity.

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*
(When using Express Mail, the Express Mail label number is **mandatory**;
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

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37 C.F.R. 1.8(a)

37 C.F.R. 1.10*

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- ☐ transmitted by facsimile to the Patent and Trademark Office.

Date: June 17, 2004

Signature

Clifford J. Mass

(type or print name of person certifying)

Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

EXTENSION OF TERM

NOTE: "Extension of Time in Patent Cases (Supplement Amendments) — If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of December 10, 1985 (1061 O.G. 34-35).

NOTE: See 37 C.F.R. §1.645 for extensions of time in interference proceedings, and 37 C.F.R. § 1.550(c) for extensions of time in reexamination proceedings.

NOTE: 37 C.F.R. § 1.704(b)". . . an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph."

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply.

(complete (a) or (b), as applicable)

(a) ☐ Applicant petitions for an extension of time under 37 C.F.R. 1.136 (fees: 37 C.F.R. 1.17(a)(1)-(4)) for the total number of months checked below:

| | Extension (months) | Fee for other than small entity | Fee for small entity |
|--------------------------|-----------------------|------------------------------------|-------------------------|
| <input type="checkbox"/> | one month | \$ 110.00 | \$ 55.00 |
| <input type="checkbox"/> | two months | \$ 420.00 | \$ 210.00 |
| <input type="checkbox"/> | three months | \$ 950.00 | \$ 475.00 |
| <input type="checkbox"/> | four months | \$ 1,480.00 | \$ 740.00 |
| <input type="checkbox"/> | five months | \$ 2,010.00 | \$ 1,005.00 |

Fee: \$ _____

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

☐ An extension for _____ months has already been secured. The fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

OR

(b) ☒ Applicant believes that no extension of term is required. However, this is a conditional petition being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. 1.16(b)-(d)) has been calculated as shown below:

| | | | | | SMALL ENTITY | | OTHER THAN A SMALL ENTITY | | |
|--|---|-------|---------------------------------|---------------|------------------|------------|---------------------------|------------------|------------|
| (Col. 1) | | | (Col. 2) | (Col. 3) | | | | | |
| Claims Remaining After Amendment | | | Highest No. Previously Paid For | Present Extra | Rate | Addit. Fee | OR | Rate | Addit. Fee |
| Total | * | Minus | ** | = | x \$ 9= | \$ | | x \$ 18= | \$ |
| Indep. | * | Minus | *** | = | x \$ 43= | \$ | | x \$ 86= | \$ |
| <input type="checkbox"/> First Presentation of Multiple Dependent Claims | | | | | + \$145= | \$ | | + \$290= | \$ |
| | | | | | Total Addit. Fee | \$ | OR | Total Addit. Fee | \$ |

- * If the entry in Col. 1 is less than the entry in Col. 2, write "O" in Col. 3,
 ** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".
 *** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".
 The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

WARNING: "After final rejection or action (§ 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made." 37 C.F.R. 1.116(a) (emphasis added).

(complete (c) or (d), as applicable)

- (c) ☒ No additional fee for claims is required.

OR

- (d) ☐ Total additional fee for claims required \$ _____

FEE PAYMENT

5. ☐ Attached is a check in the sum of \$ _____
☐ Charge Account No. 12-0425 the sum of \$ _____
 A duplicate of this transmittal is attached.

FEE DEFICIENCY

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, (1065 O.G. 31-33).

6. ☒ If any additional extension and/or fee is required, charge Account No. 12-0425.

AND/OR

- ☒ If any additional fee for claims is required, charge Account No. 12-0425

Reg. No. 30,086

Tel. No. 212-708-1890

Customer No. 00140

SIGNATURE OF PRACTITIONER

CLIFFORD J. MASS

(type or print name of practitioner)

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Hiroyuki ONISHI, et al
Serial No.: 10/009,884 Group No.: 1746
Filed: November 13, 2001 Examiner.: William P. Fletcher III
For: METHOD FOR SURFACE-TREATMENT, SURFACE-TREATED ARTICLE
AND DEVICE FOR SURFACE TREATMENT

Attorney Docket No.: U 013711-6

Commissioner for Patents
P.O. Box 1450
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RESPONSE TO RESTRICTION ACTION

In response to the Official Action mailed May 18, 2004, wherein the
Examiner has required an election of claims, Applicants hereby elect to prosecute in

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*

*(When using Express Mail, the Express Mail label number is mandatory;
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I hereby certify that, on the date shown below, this correspondence is being:

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37 C.F.R. 1.8(a)

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TRANSMISSION

- ☐ transmitted by facsimile to the Patent and Trademark Office.

Date: June 17, 2004

Signature

CLIFFORD J. MASS

(type or print name of person certifying)

***WARNING:** Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. 1.10(b).
"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

the present application the claims of Group I, drawn to a surface treatment method. Claims 1-45 are drawn to such method. This election is made without prejudice to Applicants' right to file a divisional application or applications directed to the non-elected claims.

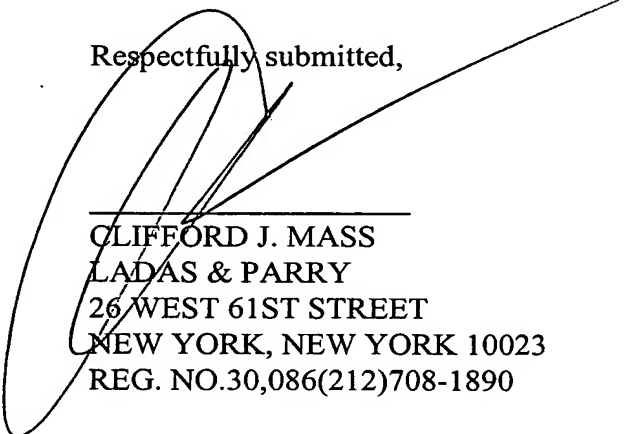
The Examiner has also requested that Applicants make an election of species and, in response to this request, Applicants hereby provisionally elect the species identified at paragraph 3.i of the Official Action (a sulfur compound treatment agent). Claims 1, 2, 3 and 8-10 read on the elected species. Applicants understand that, upon the allowance of a generic claim, they will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim, as provided by 37 CFR 1.141.

Applicants have provisionally elected a species in compliance with the Examiner's requirement, but respectfully submit that such requirement is improper under PCT unity of invention rules and should be withdrawn. As is clear from Annex B of the Administrative Instructions Under the PCT, Part 1, subparagraph (c), no problem of lack of unity arises in a case of a genus/species situation unless and until a careful consideration of the prior art shows that the independent claim(s) to the genus do not avoid the prior art. In the present case, the Examiner has referred perfunctorily to some JP references, but it is respectfully submitted that he has not applied them to the claims of the present application in a manner that would inform Applicants of the reasons that the Examiner contends that the independent claim to the genus does not

avoid the prior art. In the absence of such analysis, it is respectfully submitted that the requirement for election is at least premature. Withdrawal of the species election requirement is accordingly respectfully requested.

Applicants have responded to all of the requirements in the aforementioned Official Action and request an early and favorable examination on the merits of at least the elected claims.

Respectfully submitted,



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